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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,133	08/04/2003	Stefan Vilsmeier	SCHWP0185USA	5770

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EXAMINER

SHAHRESTANI, NASIR

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/634,133

Applicant(s)

VILSMEIER ET AL.

Examiner

Nasir Shahrestani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/4/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/30/2003
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 recites the limitation of “determining a position” and it is held that such limitations are directed to a judicial exception to 35 U.S.C. 101 being an abstract idea and it is not directed to a practical application of such judicial exception because the claim does not require any physical transformation and the invention does not produce a useful, concrete, and tangible result.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 2-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 16 and 19 recite the limitation "the patient" in line 17 of page 1, line 23 of page 10 and line 25 of page 11. There is insufficient antecedent basis for this limitation in the claims.

Claims 3, 16 recite the limitation "measuring points" in line 1 of page 9. There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-12, 18-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Cosman (U.S. Patent No.: 6,405,072).

**Regarding claims 1, 4, 19-20**, Cosman teaches a method for detecting a target volume (title) in radiotherapy or radio surgery (fig. 2), said method comprising: positionally referencing at least one implant in the vicinity of the target volume (column 3 lines 29-36).; inductively stimulating the at least one implant detecting emission from the at least one inductively stimulated implant and determining a position of the at least one implant based on the detected emission; and determining the current position of the target volume based on the determined position of the at least one implant (fig. 4; column 11 lines 6-24). Furthermore, Cosman teaches recording an image data based on the position of the at least one implant (column 6 lines 50-59).

**Regarding claim 2**, Cosman further teaches introducing the at least one implant into the patient in the vicinity of the target volume (column 11 lines 4-5); detecting the position of the implant using an imaging system (column 1 lines 65-67); and referencing an implant relative to inner organs and anatomical structures (column 3 lines 29-32).

**Regarding claim 3**, Cosman further teaches moving the patient to a therapy device after detecting the implant (column 3 lines 42-46; column 7 lines 1-6); and generating an electromagnetic field in the vicinity of but outside the patient (column 20 lines 28-31), wherein the implant inherently inductively absorbs energy and at least partially re-emits the absorbed energy being in the form of a second EM signal; and detecting said second EM signal outside the patient (column 4 lines 62-67); and determining the position of said implant relative to measuring points at which said second EM signal is detected and position of said measuring points relative to the therapy device being inherently known by user (fig. 2; fig. 10).

**Regarding claim 8**, Cosman further teaches activating the therapy device only when the position of the target volume is within a predetermined range about a current target point of the therapy device (column 21 lines 6-28).

**Regarding claims 5-6, 9**, Cosman further teaches shifting the patient for the target volume to be captured by a therapy beam (fig. 4 element 75), and further teaches adjusting a therapy beam to the position of the target volume (fig. 4 elements 76 & 85).

**Regarding claim 7**, Cosman further teaches continuously detecting the position of the implant and determining a shift in the position of the target volume caused by breathing based on the detected position (dashed lines 155; column 16 lines 60-67).

**Regarding claim 10**, Cosman further teaches wherein the measuring points are situated on a rotating portion of a linear accelerator (fig. 11 elements 40A, 40B, 40C).

**Regarding claim 11**, Cosman further teaches wherein the measuring points are integrated into a treatment couch of the therapy device (fig. 11 elements 32, 30, 31).

**Regarding claim 12**, Cosman further teaches wherein one or more measuring points are attached to a solid mobile structure as mentioned above, which position relative to the therapy device is tracked three-dimensionally by means of a real-time tracking system (column 7 lines 25-41; column 8 lines 31-41).

**Regarding claim 18**, Cosman further teaches at least one of the steps is performed in a space adjacent to a treatment position (fig. 7); and a wherein a tracking system additionally tracks the movement and position of external infrared markings (arrows 26), wherein the position and movement of the implant is referenced with respect to the position and movement of the external markings, and wherein positioning, are based only on tracking the external markings (abstract; column 2 lines 21-37).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 13-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman (U.S. Patent No.: 6,405,072) in view of Fabian (U.S. Patent No.: 5,057,095).

Cosman teaches all the limitations of claim 2 as described above but does not teach wherein at least one implant includes one or more coils. Fabian teaches implants including one or more coils (fig. 2c), which axis are not parallel to each other and are connected to different oscillating circuits. (fig. 5, column 7 lines 1-15). It would have been obvious to one of ordinary

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skill in the art at the time of the invention to have modified the method as taught by Cosman and to have further included marker implants including coils having varying oscillating circuits in order to provide for detection of surgical implements in an accurate manner and the use of various oscillating circuits or detectors provide for the detection of coils with axes of varying orientation.

**Claims 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman (U.S. Patent No.: 6,405,072) in view of well-known practices in the art.

Cosman teaches all the limitations of claims 1 as described above and further teaches determining the position of the implant relative to measuring points (column 3 lines 42-46; column 7 lines 1-6), being connected to the patient or to a couch (fig. 1; fig. 7); and teaches the measuring points are fitted with reference means and patient being moved to the measuring device using reference (fig. 4) and further teaches a three-dimensional tracking system being an optical infrared camera (camera C2). However, Cosman does not teach the patient being situated in a space or region in which there are few interference fields as possible and in which there are as few metallic parts as possible. Conventional Radiotherapy practices teach the aforementioned limitations and precautions, being well-known in the art and official notice of such is taken. It would have been obvious to one of ordinary skill in the art to have modified the method as taught by Cosman and to have further included the step of situating the patient for Radiotherapy in an area with few interference fields and external metallic parts in order to prevent distortion in transmission signals and to provide for accurate detecting means.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-12, 16-20** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,731,970 in view of Fabian (U.S. Patent No.: 5,057,095). Although the conflicting claims are not identical, claims 1-12, 16-20 are not patentably distinct while not identical in dependency, contain no additional subject matter not already in the claims of U.S. Patent No. 6,731,970.

Furthermore, claims 13-15 are rejected as being unpatentable in view of Fabian (U.S. Patent No.: 5,057,095).

The aforementioned patent teaches all the limitations of claim 2 as described above but does not teach wherein at least one implant includes one or more coils. Fabian teaches implants including one or more coils (fig. 2c), which axis are not parallel to each other and are connected



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to different oscillating circuits. (fig. 5, column 7 lines 1-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method as taught by U.S. Patent No. 6,731,970 and to have further included marker implants including coils having varying oscillating circuits in order to provide for detection of surgical implements in an accurate manner and the use of various oscillating circuits or detectors provide for the detection of coils with axes of varying orientation.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasir Shahrestani whose telephone number is 571-270-1031. The examiner can normally be reached on Mon.-Thurs: 7:30-5:00, 2nd Friday: 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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10/30/2006

  
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